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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,476	05/24/2000	Raymond V. Damadian	DAMADIAN 3.0-076	4571
530 7590 05/20/2005 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER TUGBANG, ANTHONY D	
			ART UNIT 3729	PAPER NUMBER

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 09/577,476	Applicant(s) DAMADIAN, RAYMOND V.	
	Examiner A. Dexter Tugbang	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-24 and 33-44 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☒ Claim(s) 33-44 is/are allowed.
 6) ☒ Claim(s) 7,13,17,19,20 and 24 is/are rejected.
 7) ☒ Claim(s) 8-12,14-16,18 and 21-23 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The applicant(s) amendment filed on 2/11/05 has been fully considered and made of record.

Claim Objections

2. Claims 9, 14, 17-20, 22, 23, 34, 37, 40 and 41 are objected to because of the following informalities.

In Claim 9, "a shim" (line 2) should be recited as --said shim--.

In Claim 14, "a step" (line 2) should be recited as --a step--.

In Claim 17, "an intermediate" (line 2) should be recited as --said intermediate--.

In Claim 18, "an intermediate" (line 2) should be recited as --said intermediate--.

In Claim 19, "an intermediate" (line 2) should be recited as --said intermediate--.

In Claim 20, "an intermediate" (line 2) should be recited as --said intermediate--; and --material-- should be inserted after "dielectric" (line 3).

In Claim 21, --material-- should be inserted after "dielectric" (line 2).

In Claim 22, --material-- should be inserted after "dielectric" (line 2).

In Claim 23, "said dielectric sleeve" (line 2) should be recited as --a dielectric sleeve--.

In Claim 34, "a shim" (line 3) should be recited as --said shim--.

In Claim 37, "the step" (line 2) should be recited as --a step--.

In Claim 40, "an intermediate" (line 2) should be recited as --said intermediate--.

In Claim 41, "an intermediate" (line 2) should be recited as --said intermediate--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7, 13 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelmerson et al 3,026,652.

Kelmerson discloses a method of making shim pieces comprising: providing an intermediate element (shown in Fig. 1) which includes a plurality of solid elongated ferromagnetic rods 2 extending side-by-side in a lengthwise direction with a dielectric material (concrete slab 1) therebetween; and slicing said intermediated element with a saw 4 transverse to the lengthwise direction to form a plurality of at least two shim pieces each having a thickness direction corresponding to the lengthwise direction of the rods in the intermediate element.

With respect to the process steps being drawn to a “magnetic resonance imaging magnet”, these limitations recited in the preamble of the claims are intended use limitations and have not been given patentable weight since the body of the claims do not depend upon the preamble for completeness and the process steps are able to stand alone. *In re Hirao*, 535 F.2d 67 190 USPQ 15 (CCPA 1976).

The rods 2 of Kelmerson are formed of iron, which would make the rods inherently “ferromagnetic” such that they can be called “ferromagnetic rods”.

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The material of concrete itself inherently has dielectric properties such that it can be said to be a "dielectric material" being that the claims do not recite any degree that the material must be dielectric.

Regarding Claim(s) 19, the shape of the concrete slab 1 of Kelmerson is a sleeve such that it covers the ferromagnetic rods 2 as a "dielectric sleeve".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelmerson et al in view of Chiddix et al 2,901,430.

Kelmerson discloses the claimed manufacturing method as relied upon above in Claim 7. Kelmerson does not teach cleaning the rods of other contaminants.

Chiddix teaches that cleaning metals of other contaminants in general that are utilized with dielectric materials (see col. 4, lines 37+), i.e. concrete, has the advantage of inhibiting corrosion (see col. 1, lines 10-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Kelmerson by including the step of cleaning, as taught by Chiddix, to positively inhibit corrosion of the metal rods.

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7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelmerson et al in view of Japanese Patent Publication JP 3-69310, referred to hereinafter as JP'310.

Kelmerson discloses the claimed manufacturing method as relied upon above in Claim 7. Kelmerson does not teach that the intermediate element is formed by placing the rods in a mold and curing the dielectric material around the rods.

JP'310 teaches a molding process that includes forming an intermediate element by placing the dielectric material, i.e. concrete, with ferromagnetic iron rods in a mold and curing the dielectric material (see Purpose and Constitution).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Kelmerson by using the molding process of JP'310, to provide an alternative means of forming the intermediate element having the very same dielectric material of concrete.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelmerson et al.

The rods of Kelmerson are round or circular in cross-sectional shape. However, it would have been an obvious matter of design choice to choose any desired cross-sectional shape of the rods since the applicant(s) have not disclosed that the claimed rods having a shape that is "substantially hexagonal in cross-sectional shape", solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the cross-sectional shape taught by Kelmerson et al.

Furthermore, it is noted that the shape of the rods as claimed, does not result in any manipulative difference in the recited manufacturing process steps when compared to the prior art.

Response to Arguments

9. Applicant's arguments with respect to Claims 7-24 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

10. Claims 8-12, 14-16, 18 and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 33-44 are allowed.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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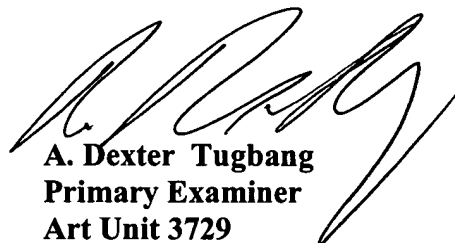
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 571-272-4570.

The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

May 16, 2005